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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,386

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Minoru Sakai

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37398

7590

05/09/2008

TAIYO CORPORATION

401 HOLLAND LANE

#407

ALEXANDRIA, VA 22314

EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

05/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/791,386	Applicant(s) SAKAI ET AL.	
	Examiner Thorl Chea	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08102007; 02142008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to the communication on February 13, 2008; claims 1-14 are pending in this instant application; claims 15-35 have been canceled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Toya et al (US Patent No. 6,335,153), Stoebe et al (US 2003/0081956), and Harai et al (US 6,475,715B2).

Toya et al discloses an image forming apparatus including exposed portion (16) equipped with a laser beam scanner and heat development portion (18) with conveying roller pairs of the conveying section 17 for developing a photothermographic material. See Fig 1; page 22, lines 25-60, and the polyhalogenate compound in column 29, lines 14-65. Stoebe et al discloses the process of forming an image using photothermal film using a compact thermal development apparatus wherein the light-exposure portion annexed to the thermal development portion. See Fig.4, wherein light source generated by light source (9) and thermal film processing using radiant energy source (22). Harai et al disclose a photothermographic material used in the process of the claimed invention. See the composition of the material which contains the polyhalogenate compound of the present invention in column 37-40, claims 1-17.

The process claimed in the present claimed invention is directed to the process for forming an image using a photothermographic material and a heat-development apparatus. The photothermographic material containing a polyhalogenate compound have been known and taught in Harai et al. The apparatus having the scanning exposure portion and the heat-development portion is taught in Toya et al such as shown above, but Toya et al do not disclose a distance between the scanning exposure position and an insertion part of the thermal portion is 50 cm or less. However, it has been known in Stoebe et al to provide a heat-development apparatus with a light-exposure portion annexed to the thermal development portion to provide a compact heat-development apparatus. Therefore, it would have been obvious to the worker of ordinary skill in the art to reconfigure heat-development apparatus taught by Toya et al by placing the light-exposure portion annexed to the thermal development portion such as taught in Stoebe et al to render the material compact, and thereby using to provide an image using the known material such as taught in Harai et al, and thereby provide a process as claimed.

Response to Arguments

4. Applicant's arguments filed February 14, 2008 have been fully considered but they are not persuasive.

The applicants argue that "the Stoebe apparatus does not provide imaging according to the present invention. Element 9 of Stoebe is not used for forming an image as can be seen from the description in Stoebe on page 17, paragraph [107]: "This film is then loaded into the thrust cartridge, and the thrust cartridge is inserted into a camera and imagewise exposed to a full color test scene. The film is then rewound into the thrust cartridge, removed from the camera, and inserted into the chamber for accepting the thrust cartridge of the apparatus of the invention"

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(emphasis added). Further, the disclosure in paragraphs [0077] to [0079] relates to optical writers that provide spatially calibrated exposure. This exposure does not form an image and is used merely for calibration. Therefore, the combination of Stoebe to Toya does not yield an apparatus with a scanning exposure portion and a thermal developing portion of 50 cm or less. Therefore, it is not seen how a person of ordinary skill could perform the claimed method in view of this combination of references.”

It is the Examiner’s position that the invention as claimed would have been found *prima facie* obvious to the worker of ordinary skill in the art at the time the invention was made. The applicants appears to argue each prior art individually while the rejections are based on the combination of the applied prior art of record. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Toya discloses an apparatus comprising means for scan exposing with a laser beam, means for transporting a photothermographic material in a sub-scanning direction and guiding it to thermal developing section. See Toya in column 22, lines 25-55. Toya may not disclose a distance between a scanning exposure position of the radiation means and the insertion part of the thermal developing portion is 50 cm or less. However, this distance between a scanning exposure position of the radiation means and the insertion part of the thermal developing portion is 50 cm or less would have been found *prima facie* obvious to the worker of ordinary skill in the art at the time the invention was made since the photothermographic material can be developed at any time after imagewise exposure. The worker of ordinary skill in the art would have placed

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the imaging exposing device annexed to the heat-development device or similar as shown in Toya with an expectation of producing an image. The applicants appears to rely on Stoebe et al reference rather than the teaching of Toya. The Examiner uses Stoebe et al to show that it has been known to place the image exposing device annexes to the image developing device in a compact development apparatus. See image exposing device (9) and heat developing device (22). The material used in the process taught in Stoebe et al is the same type used in the present claimed invention which is a material containing silver halide and silver salt of an organic acid such as benzotriazole silver emulsion and a developing agent. See table 6 on page 20. The material used in the claimed process includes both a color and black and white photothermographic material. Therefore, it would be obvious to the worker of ordinary skill in the art at the time the invention was made to modify the apparatus taught in Toya et al by placing the light exposing device annexed to the heat developing device to provide a compact development apparatus. The applicants furthermore appears to argue that the invention taught in Stoebe et al is related to material in form of a rolling web, while the material used in the claimed process is in form of a sheet. If this is the case, the applicants' argument is not persuasive since the material used in the claimed process encompasses the scope of a material in a sheet form and a roll form.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC
2008-05-06

/Thorl Chea/
Primary Examiner,
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